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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/195,852 11/19/98 HANDEL

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EXAMINER

TM02/1121

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ART UNIT

PAPER NUMBER

2177  
DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/195,852	Applicant(s) Sean Handel et al.,
Examiner Srirama Channavajjala	Group Art Unit 2177

Responsive to communication(s) filed on Continued Prosecution Application [CPA] filed on 10/30/2000

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-20 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 10 and 11

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **Response to CPA**

1. The request filed on October 30, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on Application No. 09/195,852 is acceptable and a CPA has been established, paper no. # 12.

An action on the CPA follows

2. Examiner acknowledges Applicant's Amendment, paper no. # 8, dated May 18, 2000 and corresponding final office action paper no. # 9, dated 7/30/2000.
3. Claims 1-20 remain pending in this application.
4. Claims 1,10-12 have been amended, paper no. # 8
5. Claim 20 has been added, paper no. # 8.
6. In view of the Applicant's "REMARKS" paper no. # 8, page 4, line 8-18, the rejection to Claims 5, 7, 15 and 17 under 35 USC 112, first paragraph as set in the previous office action [paper no. # 7] is hereby withdrawn.

### *Drawings*

7. The Drawing filed on 11/19/1998 are objected to by the Draftsperson under 37CFR 1.84 or 1.152, [see PTO-948, paper no.# 7].

### *Specification*

8. The title of the invention is not descriptive. A **new title** is required that is clearly indicative of the invention to which the claims are directed.

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***Information Disclosure Statement***

9. Examiner acknowledges PTO-1449, paper no. # 10 and 11, a copy of the PTO-1449 herewith enclosed along with the office action, paper no. # 14. [see attached PTO-1449].

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al., [hereafter Herz], US Patent No. 5754939.

12. As to Claims 1, 10-11, Herz details a system which including ‘user profile information’ [col 29, line 55-65], ‘obtaining at least one of a calender, email, contact list, task list, and notes from a user device’ [col 7, line 47-58, col 17, 50-53, col 29, line 11-20, line 28-32, col 63, line 55-63], ‘storing the user profile information and at least one of the calender, email, contact list, task list, and notes in a centralized, Internet-accessible database’ [col 6, line 1-10, col 7, line 47-58, col 28, line 66-67, col 29, 1-11, col 34, line 32-48, fig 1-2], specifically, in the fig 2, Herz teaches for example mass storage, proxy server S2 having database functions see col 34, line 32-37, ‘providing user access to the database from an Internet enabled device for allowing the user to alter the user profile information and access at least one of the calender, email, contact list,

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task lists, and notes' [col 27, line 43-67, col 28, line 1-7, col 34, line 32-48], contact list to be equivalent to Herz's user's group or user's list see col 73, line 57-65, col 74, line 48-56; 'receiving permission from the user to allow a third party to access the user profile information, [see abstract, col 1, line 38-42, col 37, line 41-55, col 45, line 48-67, col 46, line 1-27, line 34-40], 'proving access to the user profile information on the database to the third party' [col 37, line 38-42, col 46, line 28-67, col 47, line 26-38], 'a processor, a memory that store information under the control of the processor' [col 34, line 30-37, fig 1-2].

13. As to Claim 2, Herz details a system which including 'third party is a merchant utilizing the user profile information for offering a personalized service to the user' [col 45, line 48-67, col 46, line 1-8, col 63, line 55-63].

14. As to Claims 3 and 13, Herz details a system which including 'responding to requests for information from an Internet enabled device with appropriate information based on the user profile information' [col 32, line 25-67], service provider to be equivalent to Internet providers, for example America Online, Prodigy, CompuServe etc., see col 28, line 59-66, col 74, line 18-20.

15. As to Claims 4-5 and 14-15, Herz details a system which including 'updating the user profile information, updating the current application based on a change in the user profile information' [col 6, line 1-7, col 7, line 22-29, col 30, line 3-14].

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16. As to Claims 6 and 16, Herz details a system which including ‘storing rules indicative of information usage in the user profile information’ [col 7, line 62-67, col 8, line 1-7, col 28, line 37-40, col 34, line 32-37, see fig 1-2, more specifically, fig 2, mass storage].

17. As to Claims 7 and 17, Herz details a system which including ‘shared lists of user profile information’ [col 58, line 25-28, col 73, line 57-65].

18. As to Claims 8 and 18, Herz details a system which including ‘profile information is grouped in an optimal manner for a target application’ [col 74, line 48-56].

19. As to Claims 9 and 19, Herz details a system which including ‘Internet enabled device comprises, telephone, computer, smart card, personal digital assistant etc., [see col 30, line 38-46, col 73, line 1-8].

20. As to Claim 2, Herz details a system which including ‘securing the user profile information against access by an unauthorized Internet enabled device’ [col 29, line 14-17, col 30, line 38-46, col 45, line 42-55], user(s) provided with password(s) which prevents access by an unauthorized users, also see fig 10, elements 1101-1102.

21. As to Claim 20, Herz suggests ‘synchronizing at least one of the calendar, email, contact list, task list, and notes stored on a portable computing device of the user and the database’ [col 28, line 55-67, col 55, line 28-40, col 30, line 38-46], synchronizing to be equivalent to Henz’s reconciling different versions of data files.

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***Response to Arguments***

22. Applicant's arguments filed on May 18, 2000 have been fully considered but are moot in view of the new ground(s) of rejection.

23. Applicant argues in page 4, line 26-28, it is argued that this novel combination is critical for allowing the user to maintain one version of the user profile information, calender, email, contact list, task list, and notes so that the user access them whenever they are needed and in whatever formats they are needed.

Firstly, Henz teaches generating the user profiles in a customized electronic media based, where Henz explains various possible profiles for example users profile, target profile, query profile [see Abstract, col 4, line 50-65], Secondly, Henz teaches using Internet [see fig 1-2, see col 66, line 40-44], thirdly, Henz suggests to target objects may be electronic mail messages, or purchasable goods [see col 17, line 50-54], calender, contact list, task list and notes are inherent aspects of Henz's invention because Henz clearly details using electronic mail messages as a tool of communication, see col 63, line 50-67. Finally, Henz also details reconciling of different versions of data files see col 55, line 28-40, therefore, applicant's arguments are not persuasive.

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*Conclusion*

**The prior art made of record**

- a. US Patent No. 5987454
- b. US Patent No. 6009410
- c. US Patent No. 5754939

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All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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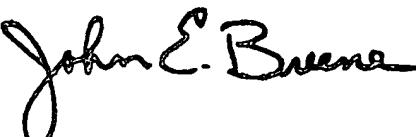
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is (703)308-8538. The examiner can normally be reached on Monday-Friday from 7:30 AM to 4:00 PM Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703)305-9790. The fax phone number for this Art Unit is (703)308-5403

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-9600.

cs

  
November 17, 2000.



JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
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